

S/N 08/968,034

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	JONSSON	Examiner:	T. SOOHOO
Serial No.:	08/968,034	Group Art Unit:	1723
Filed:	NOVEMBER 12, 1997	Docket No.:	11709.45USC1
Title:	METHOD AND DEVICE FOR FEEDING COMPONENTS FOR BONE CEMENT INTO A MIXING VESSEL FOR THESE		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence and the paper(s), as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Office of Petitions, Box DAC, Commissioner for Patents, Washington, D.C. 20231, on September 24, 2002.

By:   
Name: John J. Gresens

Office of Petitions  
Box DAC  
Commissioner for Patents  
Washington, D.C. 20231

PETITION TO TREAT NOVEMBER 13, 1995 APPLICATION FILING  
AS A FILING UNDER 35 U.S.C. 111(a)

Dear Sir:

Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183, Applicants respectfully petition the Commissioner to treat U.S. Patent Application No. 08/545,591 (hereinafter "the '591 application"), from which priority is claimed in the present application, as a Continuation-in-Part application of Patent Cooperation Treaty Application SE94/00415 under 35 USC 111(a). In addition, upon granting the petition, Applicants request that the substitute specification filed on November 13, 1995 in the '591 application be considered part of the original application papers so as to be granted a filing date of November 13, 1995.

A. Introduction

1. The present patent application was submitted to the U.S. Patent and Trademark Office on November 12, 1997 as a continuation application of parent application U.S. Patent

Application No. 08/734,817 (hereinafter "the '817 application") filed on October 22, 1996. The '817 application was filed as a continuation-in-part of the '591 application filed on November 13, 1995.

2. The present patent application claims priority to both the '817 application and the '591 application.
3. The '591 application was filed with a specification containing 12 pages of description, 8 pages of claims, 1 abstract page, and 12 sheets of drawings. The specification contained subject matter not disclosed in PCT/SE94/00415, for example Figures 7-13 and description therefor, as well as claims reciting features of one or more of the embodiments in Figures 7-13. (Copy submitted herewith as Exhibit A.)
4. In the office action mailed March 21, 1997 in the '591 application, the Examiner stated that the specification was denied entry and the subject matter disclosed therein was not considered part of the original disclosure. One of the stated reasons for denying entry was that Applicant failed to request a continuation-in-part application under 37 CFR 1.62 for a national application under 35 USC 111(a). (Copy submitted herewith as Exhibit B.)
5. The '591 application was filed with transmittal papers. (Copy submitted herewith as Exhibit C.)
6. The '591 application was also filed with a paper labeled "VOLUNTARY PRELIMINARY AMENDMENT" which contained the following statements:

"In connection with the national phase filing of the subject PCT application..."

"...take the actual date of filing and not the international filing date."

"If there are any problems relating to this procedure, which is in the nature of a continuation-in-part filing..."

(Copy submitted herewith as Exhibit D.)
7. On November 13, 1995, 37 CFR 1.495(g) stated that:

"The documents submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111."

(Copy submitted herewith as Exhibit E.)

8. On November 13, 1995, the policies of the U.S. Patent and Trademark Office required that:

"...applicant's application papers must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371; otherwise the submission will be considered as being made under 35 U.S.C. 111."

"Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a)."

(Manual of Patent Examining Procedure 6<sup>th</sup> Edition, Revision No. 1, September 1995, at § 1893.03(a), copy submitted herewith as Exhibit F).

9. The '591 application was treated by the U.S. Patent and Trademark Office as a national stage filing under 35 U.S.C. 371 as indicated on the filing receipt. (Copy submitted herewith as Exhibit G.)
10. While the filing was treated as a national stage entry, the '591 application papers contained at least two instructions that the filing was to be treated as a continuation-in-part application under 35 U.S.C. 111(a) of the PCT application, rather than as a national stage filing under 35 U.S.C. 371. Therefore, Applicant's instructions as to how to treat the '591 application papers were clear. To the extent that the application papers were equivocal, conflicting, or otherwise unclear, U.S. Patent and Trademark Office policy dictated that the filing be deemed made under 35 U.S.C. 111. Accordingly, based on Applicant's instructions and under U.S. Patent and Trademark Office policy in effect at the time, the '591 application papers should have been treated as a continuation-in-part filing under 35 USC 111(a).

#### **B. Reasons For Granting This Petition**

This petition should be granted, and the '591 application treated as a continuation-in-part filing under 35 USC 111(a), because Applicant's instructions with respect to the filing of the '591 application were clear. Even if Applicant's instructions are deemed equivocal or unclear, U.S.

Patent and Trademark Office policy dictates that the filing in question be treated as made pursuant to 35 U.S.C. 111.

On November 13, 1995, Applicants filed the '591 application. The '591 application was originally filed with a specification containing 12 pages of description, 8 pages of claims, 1 abstract page, and 12 sheets of drawings (Exhibit A). The specification contained subject matter not disclosed in PCT/SE94/00415, for example Figures 7-13 and description therefor, as well as claims reciting features of one or more of the embodiments in Figures 7-13.

Also filed with the '591 application on November 13, 1995 was a preliminary amendment (Exhibit D) which contained the following statements:

"In connection with the national phase filing of the subject PCT application..."

"...take the actual date of filing and not the international filing date."

"If there are any problems relating to this procedure, which is in the nature of a continuation-in-part filing..."

In the office action mailed March 21, 1997 (Exhibit B), the Examiner stated that the specification filed with the preliminary amendment on November 13, 1995 was denied entry and the subject matter disclosed therein was not considered part of the original disclosure. One of the stated reasons for denying entry was that Applicant failed to request a continuation-in-part application under 37 CFR 1.62 for a national application under 35 USC 111(a).

The preliminary amendment filed on November 13, 1995 with the original '591 application papers instructed that the filing was to have the filing date of the date of submission of the '591 application and not the PCT filing date due to a substitute specification that contained new matter, and that the filing was a continuation-in-part filing. Because there are no continuation-in-part procedures involving national stage filings under 35 USC 371, the reference to a continuation-in-part filing was an instruction that the application was to be treated as a continuation-in-part application of the PCT application under 35 USC 111(a).

In accordance with the policies of the U.S. Patent and Trademark Office policy in effect at the time of the filing of the '591 application, Applicant's instructions should have resulted in

the '591 application being treated as a filing under 35 USC 111(a) rather than as a national stage filing under 35 USC 371.

In addition, all of the papers necessary for granting a filing date to an application under 35 USC 111(a) were present on the November 13, 1995 filing of the '591 application.

**C. Relief Requested**

Accordingly, Applicants respectfully request that the U.S. Patent and Trademark Office consider the '591 application filed on November 13, 1995 to have been filed under 35 USC 111(a), rather than under 35 USC 371.


In addition, Applicants respectfully request that the substitute specification and preliminary amendment filed on November 13, 1995 in the '591 application be considered part of the original application papers and that all subject matter disclosed therein be granted a filing date of November 13, 1995.



Dated: September 24, 2002

Respectfully Submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
(612) 332-5300

By   
John J. Grejens  
Reg. No. 33,112  
JJG/JAL